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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/725,952

12/01/2003

William Bachovchin

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3968

7590

10/13/2006

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EXAMINER

BORIN, MICHAEL L

ART UNIT

PAPER NUMBER

1631

DATE MAILED: 10/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/725,952	<b>Applicant(s)</b> BACHOVCHIN ET AL.	
	<b>Examiner</b> Michael Borin	<b>Art Unit</b> 1631	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 26-35 is/are pending in the application.  
     4a) Of the above claim(s) 33-35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 26-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/25/05, 5/15/06, 4/4/05</u> | 6) <input type="checkbox"/> Other: ____.  |

### ***Status of Claims***

1. Claims 26-35 are pending.

Response to restriction requirement filed 07/24/2006 is acknowledged. Applicant elected, with traverse, Group I, claims 26-32<sup>1</sup>. Applicant argues that search and examination would not represent an undue burden, but does not provide reasons for such position. The restriction requirement is still deemed proper and is therefore made FINAL. Claims 33-35 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected groups. Cancellation of claims 33-35 is requested.

### ***Double Patenting***

2. Claims 26-32 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of US 6258597.

An obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but an examined application claim is not patentably distinct from the referenced claims because the examined claim is either anticipated, or would have been obvious over, the reference claims. See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir.1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir.1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir.1985).

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<sup>1</sup> In the restriction requirement, due to an inadvertent error, claim 33 was indicated as part of Group I, although the claim is directed to subject matter of Group II.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the '597 claims are directed to method for stimulating hematopoietic cells in vitro by culturing the cells in the presence of DP IV inhibitor and in the absence of cytokines. The referenced claims are silent about presence or absence of stromal cells and, therefore, are viewed as encompassing the embodiment of culturing in the absence of stromal cells.

3. Claims 26, 27 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 9,11,15,18 of U.S. Patent No. 6703238.

An obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but an examined application claim is not patentably distinct from the referenced claims because the examined claim is either anticipated, or would have been obvious over, the reference claims. See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir.1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir.1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir.1985).

Although the conflicting claims are not identical, they are not patentably distinct from each other because the '238 claims are directed to method for expanding T cells comprising culturing hematopoietic cells with DP IV inhibitors in the absence of cytokines and stromal cells.

4. Claims 28-32 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 9,11,15,18 of U.S. Patent No. 6703238 in view of claims 1-7 of US 6258597.

Although the claims of '3238 are not directed to particular DP IV inhibitor species or conditions of culturing, selection of such result-oriented species and conditions would be obvious to one skilled in the art. See claims 3-7 of US 6258597, for example.

***Prior art made of record***

5. PCT/US93/017173, published as WO94/03055, teaches method for stimulating hematopoietic cells in vitro by culturing the cells in the presence of DP IV inhibitor; however, the conditions described in the reference require presence of cytokines as an essential element for maintaining and stimulating the growth and differentiation of hematopoietic cells in culture. See examples 1,2, for example.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Borin whose telephone number is (571) 272-0713. The examiner can normally be reached on 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on (571) 272-0811. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Michael Borin, Ph.D.

Primary Examiner

Art Unit 1631

mlb